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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,691	04/17/2001	Donald Soares	52295/00101	7169

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,691

Applicant(s)

SOARES ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.
5) ☒ Claim(s) 1-30 and 33-41 is/are allowed.
6) ☒ Claim(s) 31 and 32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
3. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
- 3.1 Claims 31 & 32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.
- 3.1.1 The instant claims recite a method comprising a series of steps to be performed on a computer, (claims 31 & 32), which has a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.
- 3.1.2 In regard to claims 31 & 32, the invention as set forth in these claims merely describes:
 - A) using a first set of specifications to determine a first estimated cost for producing a print job;
 - B) modifying the first set of specifications into a second set of modified specifications which are used to determine a second estimated cost for producing a print job;

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C) determining the compliance of the invoiced price of producing the print job by determining if the invoiced cost of producing the print job is not substantially higher than the second estimated cost of producing a print job; and

D) claim 32 adds the concept of penalizing the printer if the invoice does not comply with the pricing model, however, the exact nature of the penalty is unknown and therefore is an abstract idea.

However, the process as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

3.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter; or any new and useful improvement thereof, which is either:

A) altered or changed or modified by the invention recited in claims; or

B) utilizes the result of the invention recited in these claims; or

C) is operated or controlled by the result of the invention recited in these claims.

3.1.4 It is further noted in regard to claims 31 & 32, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 31 & 32 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of determining two price values and comparing the second cost value to an invoiced cost with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

3.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

3.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

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3.1.7 In view of the above analysis claims 31 & 32, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

4.1 A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Farrrell (5,383,129), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job.

(2) Akita (JP 10-171875), which discloses using a stored bill/charge/rate information and the specifications of a manufacturing job to estimated the cost of the manufacturing job as well as the required raw materials.

(3) either Maruta (6,064,838) or Antoniak or Sevcik et al (6,330,542), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job, where the operator may change the specifications of the print job before the job is started.

(4) Watanabe (JP 2001-92616), which discloses using a stored bill/charge/rate information and the specification of a print job sent over a network to estimated the cost of the printing job.

(5) either Quallen et al (2002/0128953) or Soars et al (2002/0152183), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimate the cost of the printing job, where the buyer and seller may negotiate the estimate.

B) however, in regard to claims 1, 21 & 34, the prior art does not teach or suggest a printing job cost estimating system in which a central location:

(1) uses the specifications that describe a print job, as received from a buyer, to determine an estimated cost for producing the print job by a number of print providers by using the respective cost data provided by the respective print providers;

(2) notified the buyer of at least the lowest cost estimate; and

(3) permits the print providers and the buyer to negotiate the print job specifications and cost estimates in order to select a print provider for producing the print job.

Claims 2-20, 22-30, 35 & 36 are allowable for the same reason.

C) however, in regard to claims 31 & 33, the prior art does not teach or suggest a printing estimating system in which:

(1) a first estimated cost of a print job is determined based on received set of specifications for a print job,

(2) the received set of specifications for the print job is modified into a second set of specifications for the print job and a second estimated cost of the print job is determined based on second set of modified specifications for the print job; and

(3) the invoice of the print provider is determined to be in compliance with a pricing model if actual cost of producing the print job is not substantially greater than the second estimated cost of producing the print job.

Claim 32 is allowable for the same reason.

D) however, in regard to claim 37, the prior art does not teach or suggest a printing job cost estimating system in which a central location:

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(1) uses the specifications that describe a print job, as received from a buyer, to determine an estimated cost for producing the print job by a print provider by using the respective cost data provided by the print provider;

(2) notified the buyer of at least the cost estimate; and

(3) permits the print provider and the buyer to negotiate the print job specifications and cost estimates in order to select a print provider for producing the print job.

Claims 38-41 are allowable for the same reason.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 101 rejection, in view of the above modified rejection, applicant's arguments are non persuasive.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

7.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

7.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

11/29/04


Edward R. Cosimano
Primary Examiner A.U. 3629